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Dated: April 24, 2009 Signature: /Mark D. Russett/
Mark D. Russett, Reg. No. 41,281

Docket No.: 62041(51588)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 7,494,642 of:
Elmaleh, *et al.*

Issued: February 24, 2009

Application No.: 10/827,054

Confirmation No.: 2370

Filed: April 19, 2004

Art Unit: 1618

For: METHOD FOR MONITORING BLOOD
FLOW AND METABOLIC UPTAKE IN
TISSUE WITH RADIOLABELED ALKANOIC
ACID

Examiner: Melissa J. Perreira

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705(d)

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Request for Reconsideration of Patent Term Adjustment (PTA) under 37 C.F.R. § 1.705(d) (or, alternatively, a Petition for Review of Patent Term Adjustment under 37 C.F.R. §§ 1.181 & 1.705(d), if appropriate) to correct the Patent Term Adjustment for the above-referenced patent application.

It is respectfully submitted that the Patent Term Adjustment of four hundred thirty-nine (439) days accorded by the United States Patent and Trademark Office ("Office") to the above-referenced application in the Notice of Allowance and the "Determination of Patent Term Adjustment" mailed September 26, 2008, and as shown on the face of the issued patent, is not correct, or at least is not complete. Applicants respectfully request the grant of a minimum Patent Term Adjustment of six hundred fifty-seven (657) days.

STATEMENT OF FACTS

1. Applicants filed the instant application pursuant to 35 U.S.C. § 111(a) on April 19, 2004.
2. The Office mailed a Restriction Requirement on September 21, 2006. This was the first action under 35 U.S.C. § 132 in the application. As this first action was mailed more than 14 months after the date of filing of the application, the application is entitled to 459 days of PTA pursuant to 37 C.F.R. § 1.703(a)(1), as indicated on the copy of the Patent Term Adjustment History obtained from PAIR (Appendix A). Applicants filed a response on November 3, 2006 (within three months of the mailing date of the Restriction Requirement).
3. An Office Action was mailed from the Office on December 12, 2006. Applicants filed a response on March 12, 2007 (within three months of the mailing date of the Office Action).
4. A Final Office Action was mailed from the Office on May 22, 2007. Applicants filed a response on July 20, 2007 (within three months of the mailing date of the Final Office Action). An Advisory Action was mailed from the Office on August 2, 2007. A Notice of Appeal was filed on September 24, 2008. While the response dated July 20, 2007, was timely for purposes of PTA, the Notice of Appeal filed on September 24, 2008, was regarded by the Office as untimely, and Applicants were charged with 33 days of delay, as shown in the Patent Term Adjustment History (Appendix A).
5. On November 23, 2007 (more than three years after the date that the application was filed), Applicants filed a Request for Continued Examination (RCE) and a response to the outstanding Final Office Action.

6. On February 13, 2008, a new, non-final Office Action was mailed from the Office. Applicants filed a response on May 13, 2008 (within three months of the mailing date of the Office Action).

7. Applicants filed an Information Disclosure Statement (IDS) on August 13, 2008. The IDS was filed as an IDS after an Office Action on the merits pursuant to 37 C.F.R. 1.97(c)(2). The Office evidently did not consider this IDS filing to be untimely for PTA purposes, as no days of delay were charged to Applicants in the "Determination of Patent Term Adjustment Under 34 U.S.C. 154(b)" dated September 26, 2008, discussed below.

8. A Notice of Allowance (together with related papers) was mailed on September 26, 2008. As this date was more than four months after the date a reply was filed, the application is entitled to 13 days of PTA pursuant to 37 C.F.R. § 1.703(a)(2), as indicated on the copy of the Patent Term Adjustment History obtained from PAIR (Appendix A).

9. The Notice of Allowance included a "Determination of Patent Term Adjustment Under 34 U.S.C. 154(b)" that indicated that the application would be entitled to 439 days of PTA under 35 U.S.C. § 154(b) (evidently calculated as 472 days of USPTO delay under 35 U.S.C. § 154(b)(1)(A), as discussed in paragraphs 2 and 8, above, less 33 days of Applicant delay, as discussed in paragraph 4, above), "[i]f the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice". Applicants timely paid the Issue Fee on December 24, 2008.

10. During prosecution, there was no request for continued examination, no interference proceeding, no imposition of a secrecy order, and no review by the Board of Patent Appeals and Interferences or a Federal Court, other than the Request for Continued Examination filed on November 23, 2007, and discussed in Paragraph 5 herein. The instant application/patent is not subject to a terminal disclaimer.

11. Except as set forth above, Applicants submit that there were no circumstances constituting a failure by Applicants to engage in reasonable efforts to conclude processing or examination of the patent application.

12. As the instant patent issued on February 24, 2009, and this Request/Petition is filed no later than two months after the issue date, as required by 37 C.F.R. § 1.705(d), this paper is timely filed.

13. The Director is authorized to charge the \$200.00 fee for this Request, pursuant to 37 C.F.R. § 1.18(e), to our Deposit Account No. 04-1105 under Order No. 62041(51588).

APPLICANTS ARE ENTITLED TO ADDITIONAL PATENT TERM ADJUSTMENT
UNDER 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b)

14. As discussed above, an inspection of the Patent Term Adjustments page on PAIR, a copy of which is attached hereto as Appendix A, reveals that the Office accorded, as of September 26, 2008 (the mailing date of the Notice of Allowance and Fee(s) due) and February 24, 2009 (the issue date), four hundred seventy-two (472) days of Patent Term Adjustment attributable to USPTO delay under 35 U.S.C. § 154(b)(1)(A) (albeit reduced by 33 days of Applicant delay).

15. A further inspection of the Patent Term Adjustments page on PAIR (Appendix A), reveals that the Office did not accord any days of Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) ("the Three Year Rule"). Because the Office did not accord any days of Patent Term Adjustment under the Three Year Rule, it appears that the Office either (i) has not yet calculated any Patent Term Adjustment due under the Three Year Rule, or (ii) has incorrectly applied the "double-counting" provision of 35 U.S.C. § 154(b)(2)(A).

16. 35 U.S.C. § 154(b)(2)(A) provides:

To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

17. In a Memorandum Opinion issued on September 30, 2008 in Wyeth v. Dudas, the U.S. District Court for the District of Columbia held that Office's interpretation of § 154(b)(2)(A), as published at 69 Fed. Reg. 34238 and (apparently or potentially) applied to the present patent application/patent, is incorrect. Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008), appeal docketed No. 08-5502 (Fed. Cir. Dec. 24, 2008).

18. The Wyeth court held that "[t]he only way that periods of time can 'overlap' is if they occur on the same day." Id. Accordingly if a delay under § 154(b)(1)(A) occurs on one calendar day, and a delay under § 154(b)(1)(B) occurs on another day, "they do not overlap, and § 154(b)(2)(A) does not limit the extension to one day." Id.

19. Applicants respectfully submit that the four hundred seventy-two (472) day delay under § 154(b)(1)(A) does not overlap with the delay under § 154(b)(1)(B), which is two hundred eighteen (218) days (the time period between the day after the date that is three years after the filing date of the application (*i.e.*, April 20, 2007), and the date a Request for Continued Examination was filed (November 23, 2007)).

20. The non-overlapping nature of the § 154(b)(1)(A) and § 154(b)(1)(B) delays in this application is illustrated below as Figure 1.

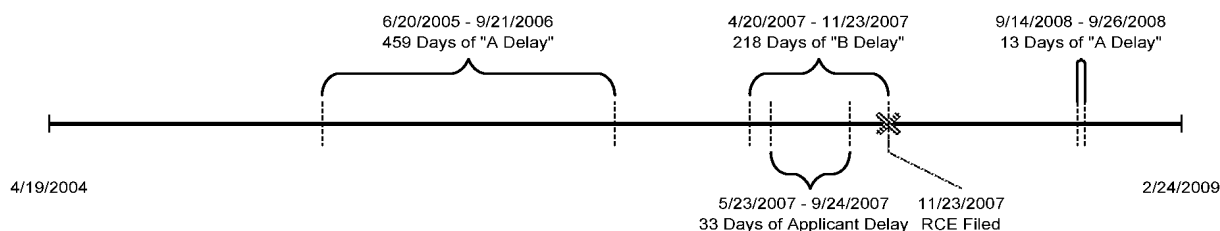


Figure 1

21. Therefore, Applicants contend that the present patent is entitled to an additional two hundred eighteen (218) days of patent term adjustment under § 154(b)(1)(B).

RELIEF REQUESTED

22. Applicants respectfully request that the Office (i) properly calculate the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) to which the present application/patent is entitled, and (ii) grant Patent Term Adjustment equal to the sum of six hundred fifty-seven (657) days (the sum of the delays under § 154(b)(1)(A) (472 days) and § 154(b)(1)(B) (218 days), less 33 days of Applicant delay, as set forth above).

23. Applicants believe that there are no further fees due in connection with this Petition other than the fee under 37 C.F.R. § 1.18(e). However, if additional fees are due, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105 under Order No. 62041 (51588).

Dated: April 24, 2009

Respectfully submitted,

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